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From: Michele Morrow Legal Assistant to Francis Lammes	No. of Pages Including Cover Sheet: 27
Message: Enclosed herewith: <ul style="list-style-type: none">• Transmittal Document; and• Appeal Brief.	
Re: Application No. 09/915,436 Attorney Docket No: AUS920010527US1	
Date: Friday, January 28, 2005	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Banerjee et al.**

Serial No.: 09/915,436

Filed: July 26, 2001

**For: Method and Apparatus for
Insuring Delivery of Electronic
Documents in a Network Data
Processing System****35525**PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Group Art Unit: 3627

Examiner: **Kramer, James A.**

Attorney Docket No.: AUS920010527US1

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By: Michele Morrow
Michele MorrowTRANSMITTAL DOCUMENTCommissioner for Patents
P.O. Box 1450
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Sir:

ENCLOSED HEREWITH:

- Appeal Brief (37 C.F.R. 41.37).

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Respectfully submitted,

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Docket No. AUS920010527US1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of: **Banerjee et al.**

Serial No. 09/915,436

Filed: July 26, 2001

For: **Method and Apparatus for
Insuring Delivery of Electronic
Documents in a Network Data
Processing System**

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Group Art Unit: 3627

Examiner: **Kramer, James A.**

**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

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By:

Michele Morrow
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APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on December 1, 2004.

The fees required under § 41.20(B)(2), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

(Appeal Brief Page 1 of 25)
Banerjee et al. - 09/915,436

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-26

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: NONE
2. Claims withdrawn from consideration but not canceled: NONE
3. Claims pending: 1-26
4. Claims allowed: NONE
5. Claims rejected: 1-26

C. CLAIMS ON APPEAL

The claims on appeal are: 1-26

STATUS OF AMENDMENTS

There are no amendments after the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER***Independent claims 1, 13, 15 and 25:***

The presently claimed invention provides a method, apparatus, and computer program product, in a data processing system, for insuring delivery of an electronic document in a data processing system. The present invention receives a request from a requestor to insure delivery of the electronic document. (Specification, page 14, lines 3-5) The present invention identifying a payment amount to insure delivery based on network characteristics of a network in which the electronic document is to be transmitted to form an identified payment amount responsive to receiving the request. (Specification, page 14, lines 9-16) The present invention sends an acknowledgment of the electronic document to the requestor, wherein the acknowledgment includes the identified payment amount. (Specification, page 15, lines 13-18) The present invention delivers the electronic document in response to receiving a reply to the acknowledgment from the requestor accepting the identified payment amount. (Specification, page 15, lines 13-22)

The means recited in independent claim 15, as well as dependent claims 16-21, may be data processing hardware within client 110 operating under control of software performing the steps described in the specification at page 16, line 25, to page 19, line 26, or equivalent. A person having ordinary skill in the art would be able to derive computer instructions on a computer readable medium given **Figures 5, 6 and 7** and the corresponding description at page 16, line 25, to page 19, line 26, without undue experimentation.

Independent claim 8:

The presently claimed invention provides a method in a data processing system, for insuring delivery of an electronic document in a data processing system. The present invention receives a request from a requestor to insure delivery of the electronic document, wherein the insurance of delivery is based on at least a number of times a party to whom insurance is being provided has been paid insurance proceeds for untimely delivery of electronic documents. (Specification, page 14, lines 3-5 and page 19, lines 18-26) The present invention receives a delivery status of the

electronic document. (Specification, page 19, lines 4-5) The present invention determines from the delivery status if the electronic document has been timely delivered. (Specification, page 19, lines 6-8) The present invention compensates the requestor if the electronic document has not been timely delivered. (Specification, page 19, lines 11-14)

Independent claims 9, 14, 22 and 26:

The presently claimed invention provides a method, apparatus, and computer program product, in a data processing system, for insuring delivery of an electronic document in a data processing system. The present invention receives an indication of a payment for insurance for a timely delivery of the electronic document using a network. (Specification, page 15, lines 17-21) The present invention provides insurance in response to the indication, wherein the payment is based on at least one of network traffic characteristics, network congestion, reliability properties of the network, value of the electronic document, and statistical transmittives. (Specification, page 14, line 12 to page 15, line 1)

The means recited in independent claim 22, as well as dependent claims 23-24, may be data processing hardware within client 110 operating under control of software performing the steps described in the specification at page 16, line 25, to page 19, line 26, or equivalent. A person having ordinary skill in the art would be able to derive computer instructions on a computer readable medium given **Figures 5, 6 and 7** and the corresponding description at page 16, line 25, to page 19, line 26, without undue experimentation.

Independent claim 12:

The presently claimed invention provides a method in a data processing system, for insuring delivery of an electronic document in a data processing system. The present invention receives an indication of a payment for insurance for a timely delivery of the electronic document using a network. (Specification, page 15, lines 17-21) The present invention provides insurance in response to the indication, wherein the payment is based on at least a number of times a party to whom insurance is being provided has been paid insurance proceeds for untimely delivery of electronic documents. (Specification, page 19, lines 18-26)

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection on appeal are as follows:

- Claims 1-26 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kokubu (U.S. Patent No. 4,868,758) in view of Official Notice.

ARGUMENT

The Final Office Action rejects claims 1-26 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kokubu (U.S. Patent No. 4,868,758) in view of Official Notice.

Kokubu is directed to a data communication system for calculating a communication charge to be charged when a given amount of data is to be transmitted, and display means for displaying the calculated communication charge prior to the data transmission.

I. Official Notice

Appellants respectfully submit that the Official Notice stated in the Office Action dated November 7, 2003 only stated that the USPS offers a person the option to purchase insurance when sending an item. The insurance is based on the value of the item being delivered and guarantees on-time delivery of the item(s). The insurance is used to provide the customer with a sense of security that their item will be delivered on time.

However, Appellants respectfully submitted in the Response filed February 9, 2004, that the USPS does not teach or suggest an identifying step that includes taking into account a value of an electronic document in addition to the network characteristics and that an identified value of the electronic document is received from the requestor. See claims 4, 5, 18 and 19.

Additionally, Appellants respectfully submitted that the USPS does not teach or suggest where the network characteristics include at least one of congestion on a network, network traffic characteristics, reliability of the network, and transmissions statistics for the network. See claims 6 and 20. Furthermore, Appellants respectfully submitted that the USPS does not teach or suggest sending a payment to requestor in response to an inability to deliver the electronic document within a guaranteed time. See claims 7 and 21. Still further, Appellants respectfully submitted that the USPS does not base the payment on at least a number of times a party to whom insurance is being provided has been paid insurance proceeds for untimely delivery of electronic documents. See claim 12.

Because the Examiner did not traverse these arguments, Appellants respectfully submit that the USPS does not teach or suggest these features and the Official Notice falls and cannot be used to supplement the teachings of the Kokubu reference.

II. 35 U.S.C. § 103, Alleged Obviousness, Claims 1-26

The Office Action rejects claims 1-26 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kokubu (U.S. Patent No. 4,868,758) in view of Official Notice. This rejection is respectfully traversed.

As to claims 1-26, the Office Action dated April 20, 2004 states:

Kokubu teaches a data communications system in which charges to deliver an electronic document over a network are provided prior to the transmission (column 1; lines 23-25). The system includes a charge table in which communication charge information is stored (column 2; lines 10-11).

Kokubu teaches in the packet communication network, the communication charge is determined depending on the amount of information transmitted, transmission speed and transmission distance (column 2; lines 14-17). Kokubu also teaches that the communication charge usually differs depending on a time at which the line is used, therefore the charge table stores communication charge information for respective time frames (column 2; lines 28-31).

Kokubu also teaches that the communication charge is calculated based on the transmission speed determined by a communication protocol and the transmission distance (column 4; lines 43-47). Examiner notes that a communication protocol represents network characteristics. This is clearly represented by the fact that rates change depending on the time of day (i.e. more expensive during peak times, when congestion is greater on the network). Examiner asserts that the only way to develop these protocols is to utilize transmission statistics for the network based on congestion and reliability.

Kokubu does not teach delivery insurance. However, as introduced in the prior office action and now relied upon as admitted prior art, it is old and well known for the post office to offer the option for users to purchase insurance when sending an item. The insurance is based on the value of the item being delivered and guarantees on-time delivery of the items. Insurance is used in order to provide the customer with a sense of security that their item will be delivered on time.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Kokubu to offer the operator insurance after presenting the charge information. In this case since the charges are based on the network characteristics the insurance would also be based on this (i.e. speed and distance) as well as the value of the material being delivered. One of ordinary skill at the time of the invention was made would have been

motivated to combine these references as taught in order to provide the customer with a sense of security that their item will be delivered on time.

Office Action dated April 20, 2004, pages 2-3.

Claim 1, which is representative of the other rejected independent claims 13, 15, and 25 with regard to similarly recited subject matter, reads as follows:

1. A method in a data processing system for insuring delivery of an electronic document, the method comprising:
 - receiving a request from a requestor to insure delivery of the electronic document;
 - responsive to receiving the request, identifying a payment amount to insure delivery based on network characteristics of a network in which the electronic document is to be transmitted to form an identified payment amount;
 - sending an acknowledgment of the electronic document to the requestor, wherein the acknowledgment includes the identified payment amount; and
 - delivering the electronic document in response to receiving a reply to the acknowledgment from the requestor accepting the identified payment amount.

Kokubu and the USPS, taken alone or in combination, fail to teach or suggest responsive to receiving the request, identifying a payment amount to insure delivery based on network characteristics of a network in which the electronic document is to be transmitted to form an identified payment amount.

The combination of Kokubu and the USPS do not teach or suggest every element of the claimed invention. While Kokubu may teach calculating a communication charge based upon data amount, transmission speed and transmission distance, Kokubu does not teach or suggest identifying a payment amount to insure delivery based on network characteristics of a network. In fact the Office Action admits that Kokubu does not teach this feature. However, the Office Action alleges that the USPS teaches this feature. As stated in the previous response dated February 9, 2004, the insurance available through the USPS is based on the value of the item being delivered and guarantees on-time delivery of the items. However, the USPS does not deliver electronic documents. Thus, one of ordinary skill in the art would not look to the USPS to provide for the deficiencies of Kokubu. That is, the USPS does not identify a payment amount to insure delivery based on network characteristics of a network in which an electronic document is to be transmitted.

Moreover, there is no suggestion in either the Kokubu reference or the services of the USPS to modify the references and services to include such features. That is, there is no teaching or suggestion in Kokubu or the USPS that a problem exists for which identifying a payment amount to insure delivery based on network characteristics of a network in which an electronic document is to be transmitted is a solution. To the contrary, Kokubu merely teaches charging based on data amount, transmission speed and transmission distance. The USPS does not identify a payment amount for a given delivery based on the congestion of the airways or traffic accidents that may delay trucks. Therefore, a person of ordinary skill in the art would not have found it obvious to combine Kokubu and the USPS.

One of ordinary skill in the art, being presented only with Kokubu and the USPS and without having prior knowledge of Appellants' claimed invention, would not have found it obvious to combine and modify Kokubu and the USPS to arrive at Appellants' claimed invention. To the contrary, even if one were somehow motivated to combine Kokubu and the USPS, and it were somehow possible to combine the two systems, the result would not be the invention as recited in claim 1. The result would be determination of a charge for delivery of an electronic document based on the size of the document, transmission speed, and transmission distance and determination of a charge for insurance of the deliver based upon the value of the contents of the electronic document.

In view of the above, Appellants respectfully submit that Kokubu and the USPS, taken alone or in combination, fail to teach or fairly suggest all of the features of claims 1, 6, 13, 15, 20 and 25. At least by virtue of their dependency on claims 1 and 15, the specific features of dependent claims 2-7 and 16-21 are not taught or suggested by Kokubu and the USPS, either alone or in combination. Accordingly, Appellants respectfully request withdrawal of the rejection of claims 1-7, 13, 15-21 and 25 under 35 U.S.C. § 103(a).

I.A. 35 U.S.C. § 103, Alleged Obviousness of Claims 6 and 20

With regard to claims 6 and 20, Kokubu and the USPS, taken alone or in combination fail to teach or suggest wherein the network characteristics includes at least one of congestion on a network, reliability of the network, and transmissions statistics for the network. Kokubu merely describes calculating a charge based upon transmission speed determined by the communication

protocol and the transmission distance. Kokubu further states that "the transmission speed is determined by a facsimile communication protocol prior to the data communication," see column 4, lines 40-43. A communication protocol is a set of rules determining the format and transmission of data, the format being the organization of information according to preset specifications. Thus, the transmission speed is an expected speed based upon the communication protocol in which the document is to be formatted. The speed at which the document is transmitted may be reduced further based upon the network characteristics of the network including the transmission statistics for the network. The transmission distance used by Kokubu is based upon destination telephone number and a charge table. Thus, the transmission speed and transmission distance used by Kokubu are communication format characteristics for the data and charge table information. Neither of which are transmission statistics for the network. In fact, nowhere in any section of Kokubu, are statistics gathered for the transmissions made by the Kokubu system.

Furthermore, the Examiner noted that a communication protocol represents network characteristics. Appellants respectfully submit that a communication protocol is a set of rules determining the format of a document to be sent through a network and not a network characteristic. Also, a rule for determining a format of a document does not clearly represented by the fact that rates change depending on the time of day. Additionally, the Examiner asserted that the only way to develop these protocols is to utilize transmission statistics for the network based on congestion and reliability. Appellants respectfully submit that communication protocols such as, ftp, HTTP, and TCP/IP, were not developed utilizing transmission statistics for the network based on congestion and reliability.

Thus, dependent claims 6 and 20 also distinguish over Kokubu and the USPS, either alone or in combination, by virtue of the specific features recited in these claims. Accordingly, Appellants respectfully request withdrawal of the rejection of claims 6 and 20 under 35 U.S.C. § 103(a).